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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,720	07/24/2001	James P. Hearn	8932-177	1799
51832	7590	01/24/2006	EXAMINER	
JONES DAY 222 EAST 41ST STREET NEW YORK, NY 10017-6702			RAMANA, ANURADHA	
			ART UNIT	PAPER NUMBER
			3733	
DATE MAILED: 01/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/910,720

Applicant(s)

HEARN ET AL.

Examiner

Anu Ramana

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 5-16, 45, 46, 49, 67, 72, 73, 76 and 78-85 is/are allowed.
- 6) ☒ Claim(s) 1, 27, 29-39, 41, 43-44, 50-54, 58, 64-65 and 86-87 is/are rejected.
- 7) ☒ Claim(s) 59 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims pending in the application are 1,2,5-16,27,29-39,41,43-46,49-54,58,59,64,65,67,72,73,76 and 78-87.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 50-54, 58-59 and 64-65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In claim 1, lines 20-21, the limitation "outside of and adjacent the outer surface of the second clamping member" is held to be new matter. Applicants' disclosure shows the stop to be flush with the outer surface of the second clamping member.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 27, 29, 35-39, 41, 43 and 86-87 are rejected under 35 U.S.C. 102(e) as being anticipated by Bremer et al. (US 6,022,351).

Bremer et al. disclose a fastener or "cranial flap clamp" including: a first clamping member 12; a second clamping member 11 having an opening 25 with teeth "forming a

cutting surface"; and a shank or extension member 13 having a weakened section or stop 23 (Figs. 1, 3 and 5, col. 3, lines 61-65, col. 4, col. 5, lines 1-10). Regarding the limitation, "forming a cutting surface," the Examiner notes that any surface can function as a cutting surface. Regarding the limitation, "substantially smooth," Bremer et al. disclose that teeth need only be provided on sufficient portions of the surfaces 18, 19 of the extension member and need not cover a majority of the shank or extension member 13 (col. 2, lines 40-51 and col. 4, lines 27-32). Thus, the extension member 13 is held to be substantially smooth.

Claims 1, 50-54, 58 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Lerch (US 5,800,436).

Lerch discloses a clamp having a first clamping member 21 with a substantially or "almost entirely" smooth concave inner surface, a second clamping member 22 with a substantially or "almost entirely" smooth concave inner surface and a shaft or "tube" or "integral extension member" 11 received in bore 211 of first clamping member 21; the extension member 11 having a head 111 to prevent the first clamping member 21 from sliding off the extension member (col. 1, lines 42-51, col. 2, lines 50-64 and Figure 6). Lerch further discloses a notch or "stop" or "proximal flared portion" or "crimp" 112c located outside of and adjacent to the outer surface of the second clamping member (Fig. 6 and col. 3, lines 34-43).

Regarding the limitation, "stop formed by twisting against the cutting surface and shearing of the extension member," the method by which an apparatus is made, is not given any patentable weight in an apparatus claim (*In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bremer et al. (US 6,022,351).

Bremer et al. disclose all elements of the claimed invention except for fastener holes in the second clamping member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided fastener holes in the second clamping member for securing the second clamping member since it is well known in the art to utilize fasteners for the purpose of securing a member to a surface.

Further, Applicant has not disclosed that providing fastener holes in the second clamping member solves any stated problem or is for any particular purpose. Accordingly, provision of fastener holes in the second clamping member is deemed to be a design consideration that fails to patentably distinguish over the prior art of Bremer et al.

Claims 30-32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bremer et al. (US 6,022,351), as applied to claims 11 and 27, further in view of Herrington et al. (US 6,379,363).

Bremer et al. disclose all elements of the claimed invention except: (1) for an extension member that is a tube; (2) an opening having a circular shape; (3) a head disposed on the extension member proximate the first clamping member; (4) radial cutouts on the second clamping member; and (5) a fastener hole in the second clamping member.

Herrington et al. teach a cranial clamp having a first clamping member 12, a head 30 disposed proximate first clamping member with a bore, an extension member or tube 16 placed in the bore of head 30, a second clamping member 14, a circular opening 59 to receive the extension member, radial cutouts on the second clamping member forming protrusions 52 and an integrally formed stop member or crimp or ridge

or twisted portion or flared portion 34 which limits the movement of clamping member 14 on extension member 16 (Figures 1 and 21e, col. 4, lines 12-58).

Regarding claim 30, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided radial cutouts in the second clamping member of Bremer et al., as taught by Herrington et al., to rigidly retain the second clamping member against the cranial flap and skull.

Regarding claims 31-32 and 34, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an extension member in the form of a tube received in a bore of a head proximate first clamping member wherein the extension member is received in a circular opening in the second clamping member, as taught by Herrington et al., since it was known in the art to provide an extension member in the form of a tube wherein the extension member is received in a circular opening in the second clamping member.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bremer et al. (US 6,022,351) further in view of Lerch (US 5,800,436).

Bremer et al. disclose all elements of the claimed invention except for: (1) an extension member slidably attached to the first clamping member; and (2) a head disposed on the extension member proximate the first clamping member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the extension member 13 separate from first clamping member 12, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Lerch teaches a clamp with an extension member slidably receiving a first clamping member wherein a head 111 is disposed on the extension member proximate the first clamping member to prevent the first clamping member from sliding off the extension member (Figs. 1, 4 and 7, col. 2, lines 50-64 and col. 3, lines 1-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a head 111 on the extension member of the Bremer et al. device, to prevent the first clamping member from sliding off the extension member, as taught by Lerch.

Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lerch (US 5,800,436).

Lerch discloses all elements of the claimed invention except for fastener holes in the second clamping member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided fastener holes in the second clamping member for securing the second clamping member since it is well known in the art to utilize fasteners for the purpose of securing a member to a surface.

Further, Applicant has not disclosed that providing fastener holes in the second clamping member solves any stated problem or is for any particular purpose. Accordingly, provision of fastener holes in the second clamping member is deemed to be a design consideration that fails to patentably distinguish over the prior art of Bremer et al.

### ***Allowable Subject Matter***

Claims 2, 5-16, 45-46, 49, 67, 72-73, 76 and 78-85 are allowed.

Claim 59 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on November 10, 2005 have been fully considered but are not persuasive for the following reasons.



Applicants' arguments with respect to claims 1, 50-54, 58-59 and 64-65 are moot in view of the new grounds of rejection.

Applicants' arguments with respect to claim 27 are not persuasive. Bremer et al. clearly show an integrally formed stop 14 that abuts the second clamping member (Figure 6 and col. 4, lines 28-67 and col. 5, lines 1-57).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anuradha Ramana*  
January 22, 2006

  
**EDUARDO C. ROBERT**  
SUPERVISORY PATENT EXAMINER